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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,944	09/27/2001	Robert A. Dunstan	42390P11892	5051

8791 7590 01/16/2007
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EXAMINER

TRAN, NGHI V

ART UNIT	PAPER NUMBER
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2151

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above; the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/966,944

Applicant(s)

DUNSTAN, ROBERT A.

Examiner

Nghi V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-22, 24, 26, 28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-22, 24, 26, 28, and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on December 22, 2006. Claims 1, 6, 13, and 18 have been amended. Claims 23, 25, 27, and 29 have been canceled. Therefore, claims 1-14, 16-22, 24, 26, 28, and 30 are presented for further examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2006 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 6, 13, 18, 24, 26, 28, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants wrote, "the electronic device does not transmit service requests" (emphasized added). The examiner cannot find any support for this limitation. The examiner considers the "not" as a negative limitation. According to MPEP2173.05(i) "Any negative limitation or exclusionary proviso must have basis in the original disclosure". Since the applicants does not positively describe that the device does not transmit service requests.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14, 16-22, 24, 26, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng, U.S. Patent Application Publication No. 2002/0078161 (hereinafter Cheng), in view of Graziano et al., United States Patent Application Publication Number 2002/0111698 (hereinafter Graziano).

7. With respect to claims 1, 6, 13, 18, 24, 26, 28, and 30, Cheng teaches an apparatus [fig.1 and see abstract] comprising: an electronic device [i.e. UPnP controller (UCP) 120] for coupling to a home network system [figs.1-2], the electronic device

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having a memory device, the memory device contains a remote location's complete address [i.e. IP address] to a page storing one of control and characteristic information for the electronic device, one of the control and the characteristic information is retrieved from the remote location if the home network system does not have the one of control and the characteristic information stored [paragraphs 0019 and 0025-0033].

However, Cheng does not explicitly show the home network system achieves plug-n-play like operability for the electronic device without using a plug and play protocol, and the device does not transmit service requests.

In a communication apparatus, Graziano suggests or discloses the home network system achieves plug-n-play like operability [i.e. detecting even that occurred on a home device, step **1002** of fig.10] for the electronic device without using a plug and play protocol [For example, Graziano teaches home attendant **31** detects event that occurred on a home device **30a-30n**, step **1002** of fig.10. Further, Graziano discloses or suggests home attendant **31** communicates with home device **40a-40n**, see fig.3, using X10 protocol, see fig.11 and paragraph 0040], and the device does not transmit service requests [fig.11].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Cheng in view of Graziano by achieving plug-n-play operability using a plug and play protocol because this feature allow a user to directly access home attendant and to generate an/or modify configuration information and/or control and/or monitor home devices [Graziano, paragraph 0048]. It is for this

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reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to control various home devices [Graziano, paragraph 0006].

8. With respect to claims 2, 8, and 16, Cheng further teaches the complete address includes one of a complete uniform resource locator (URL) and a complete Internet protocol (IP) address to a specific page for the electronic device [paragraph 0027].

9. With respect to claims 3 and 8, Cheng further teaches the electronic device's characteristics and control information is maintained at the remote location [fig.1 and paragraphs 0028-0030].

9. With respect to claims 4 and 10, Cheng further teaches the electronic device is a consumer electronic (CE) device [120 i.e. UPnP controller].

10. With respect to claims 5 and 12, Cheng further teaches the electronic device transmits the complete device identification information [paragraph 0066 i.e. a service identification] on a device specific bus [205] when coupled to the device specific bus [figs.1-2 and paragraphs 0008-0009].

11. With respect to claim 7, Cheng further teaches a central processing device [130 i.e. file server] coupled to the home network; a central memory device coupled to the

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central processing device; and a display coupled to the central processing device [paragraphs 0040-0058].

12. With respect to claim 11, Cheng further teaches the remote network is one of the Internet and an Intranet [paragraphs 0008-0009].

13. With respect to claims 14 and 19, Cheng further teaches using the device's characteristic information to control the device; determining whether the stored characteristic information needs to be updated; and replacing the stored characteristic information with new characteristic information if the stored characteristic information needs to be updated [paragraphs 0018-0030].

14. With respect to claims 17 and 22, Cheng further teaches displaying information on a display device [fig.1 and paragraphs 0004-0007].

Response to Arguments

15. Applicant's arguments with respect to claims 1-14, 16-22, 24, 26, 28, and 30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi Tran
Patent Examiner
Art Unit 2151

January 5, 2007


ZARNI MAUNG
SUPERVISOR, PATENT EXAMINER